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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

USG-1035-362

Application Number

10/035,159

Filed

January 4, 2002

First Named Inventor

YOSHIURA

Art Unit

3692

Examiner

MAGUIRE, Lindsay M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 37,334
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____

Signature

Updeep S. Gill

Typed or printed name

703-816-4030

Requester's telephone number

May 16, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

YOSHIURA et al

Atty. Ref.: 1035-362; Confirmation No. 1757

Appl. No. 10/035,159

TC/A.U. 3692

Filed: January 4, 2002

Examiner: MAGUIRE, Lindsay M.

For: INFORMATION COMMUNICATION APPARATUS, SERVICE PROVIDING
SYSTEM, INFORMATION COMMUNICATION METHOD, INFORMATION
COMMUNICATION PROGRAM, RECORDING MEDIUM STORING THE
INFORMATION COMMUNICATION PROGRAM

* * * * *

May 16, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the OG Notice of July 12, 2005, Applicant hereby requests a
pre-appeal brief review of this case for at least the reasons set forth herein. A

Notice of Appeal is filed concurrently herewith

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-19, 23-31, 33, 35, 37-40 and 43 are pending in the application.

Claims 1, 4-10, 12 and 37 were rejected under 35 U.S.C. §103(a) as being allegedly “obvious” over Spear et al. (U.S. Patent No. 6,486,439, hereinafter “Spear”) in view of Blankenship et al. (U.S. Patent No. 6,624,388, hereinafter “Blankenship”). Applicants respectfully traverse this rejection

The references to Spear and Blankenship are based on related applications, and are directed generally to systems and methods for purportedly providing automated welding information exchange and replacement part order generation, and for providing a distributed welding architecture.

The Office Action concedes that Spear fails to disclose or suggest the specifically claimed feature of the information generating section presuming a time when life of the article required for maintenance of the user device will end, and generating purchase information at a time calculated by subtracting from the presumed time a purchase time required between transmission of the purchase information and reception of delivery of the article. The Office Action takes the position that the related disclosure to Blankenship overcomes this admitted and fundamental deficiency of Spear. This position is simply incorrect and unsupported by Blankenship itself.

Specifically, the Office Action points to Col. 3, lines 47-63, Figure 14 and Col. 15, lines 48-67, of Blankenship as allegedly teaching this specifically claimed

feature. The recitations in Blankenship relate to *monitoring* of welding materials and supply information from the weld monitoring component. The supply information is *monitored* and compared to predetermined supply threshold values. Orders are placed as supplies diminish *based on the result of the monitoring* (see, e.g., Col. 3, lines 58-60). “Monitoring” is virtually the opposite of presuming a time of life of an article. When one actually “monitors” an item, there is no need to presume how long the item is going to last, the monitoring would ostensibly do this. Thus, the teaching in Blankenship of monitoring (either automatically or manually) teaches specifically away from the claimed feature of presuming a time of life of an article. It is also important to note that there is no teaching or suggestion anywhere in Blankenship that any threshold value is a presumed life of a maintenance article. Of course, this is not surprising given that Blankenship requires monitoring of the item. There is also no teaching or suggestion in Blankenship that the time required for purchase is ever taken into account when ordering the supplies. Applicants’ review of the references does not uncover any teaching or suggestion of the specifically claimed features.

The PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

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with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Moreover, the proposed combination must teach or suggest all claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Contrary to the standards articulated above for establishing a *prima facie* case of obviousness, the outstanding Office Action makes merely conclusory statements with no rational underpinning to support the conclusion of obviousness. Specifically, in response to applicants arguments, the Office Action alleges that the mere fact that perishable items are monitored would make it obvious to one of ordinary skill in the art that this “pertains” to the presumed life of an article (pertaining is not teaching). This logic is simply untenable in the context of obviousness. As discussed above, “monitoring” is virtually the antithesis of presuming a time of life. Why would anyone monitoring the supply of a perishable item ever use a presumed time of life of an item as a basis for ordering the item?

Because there is simply no teaching of the claimed feature of presuming a time when life of the article required for maintenance of the user device will end, there can be no teaching of the specifically claimed feature of generating purchase information at a time calculated by subtracting from the presumed time a purchase

time required between transmission of the purchase information and reception of delivery of the article.

It is respectfully submitted that neither Spear nor Blankenship, either singly or in combination, disclose, teach or suggest the feature of the information generating section that presumes a time when life of the article required by the user device will end, and generates the purchase information at a time calculated by subtracting from the presumed time a purchase time required between transmission of the purchase information by the communication section and reception of a delivery of the article.

Therefore, even if, *arguendo*, the combination of Spear and Blankenship were proper, the combination nevertheless fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 2, 3, 11, 13-19, 23-31, 33, 35, 38-40 and 43 were rejected under 35 U.S.C. §103(a) as being allegedly obvious over Spear in view Blankenship, and further in view of Heimermann et al. (U.S. Patent No. 7,110,976, hereinafter "Heimermann"). Applicants respectfully traverse this rejection.

It is respectfully submitted that Heimermann fails to overcome the fundamental deficiencies noted above with respect to Spear and Blankenship. There is no teaching or suggestion in Heimermann of the claimed information

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generation based on presumed time of the end of life of an article. Therefore, even if, *arguendo*, the combination of Heimermann and Spear and Blankenship were proper, the combination nevertheless fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing, it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited

Respectfully submitted,

NIXON & VANDERHYTE P.C.

By: _____



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